


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	:	ARSENAULT et al.)	<u>Certificate of Transmission under 37 CFR 1.8</u>
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Filed	:	January 27, 2000)	transmitted to the United States Patent and
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Title	:	System and Method for)	
		Transmitting, Receiving)	
		and Displaying)	
		Advertisements)	Janet Shibata
)	
Art Unit	:	3688)	
)	
Examiner	:	Jean D. Janvier)	
)	

BRIEF ON APPEAL

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Notice of Appeal received by the United States Patent and Trademark Office on March 1, 2010, in connection with the above-referenced patent application, the Applicants respectfully submit this Brief on Appeal in accordance with 37 C.F.R. § 41.37.

I. Real Party In Interest

The real party in interest in this matter is The DIRECTV Group, Inc., of El Segundo, California.

II. Related Appeals and Interferences

An appeal brief in this application was filed on May 12, 2003, and attached as Appendix B is the decision on appeal from the Board mailed on November 5, 2004.

A pre-appeal brief in this application was filed on July 6, 2009, and attached as Appendix C is the notice of panel decision from pre-appeal brief review mailed on September 8, 2009.

III. Status of the Claims

Claims 1-17 and 35-40 are canceled. Claims 18-34 and 41-67 are pending in this application. The pending claims are presented in Appendix A of this Brief. Claims 18-34 and 41-67 stand rejected. In particular, claims 18-23, 24, 32-34, 41-47, 56, 62, 64, and 67 are rejected under 35 U.S.C. § 103(a) as unpatentable over Gerace (WO 97/41673) in view of Barrett et al. (US 6,023,727). In addition, claims 18-34 and 41-67 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hite et al. (US 5,774,170) in view of Barrett et al. Therefore, claims 18-34 and 41-67 form the subject matter of this appeal.

IV. Status of the Amendments

All previously presented amendments have been entered. No amendments are pending at this time.

V. Summary of the Invention

Although reference numerals and specification citations are inserted below in accordance with 37 CFR § 41.37(c)(v), these reference numerals and specification citations are merely examples of where support may be found in the specification for the terms used in this section of this Brief. There is no intention to suggest that the terms of the claims are limited to the examples in the specification. As demonstrated by the reference numerals and specification citations below, the claims are fully supported by the specification as required by law. Nevertheless, it is improper to read limitations from the specification into the claims. Pointing out specification support for the claim terminology, as is done here to comply with 37 CFR § 41.37(c)(v), does not limit the scope of the claims to those examples from which they derive support. Nor does this exercise provide a mechanism for circumventing the law precluding reading limitations into the claims from the specification. In sum, the reference numerals and specification citations are not to be construed as claim limitations nor are they to be used in any way to limit the scope of the claims.

Independent claim 18 is directed to a system that includes a receiver (36) for use at a subscriber site (20), a processor (58) in the receiver (36), and a memory (70) communicatively coupled to the processor (58) in the receiver (36).

Applicants' Specification, p. 6, ll. 16-26; p. 9, line 18 – p. 12, line 16, FIGS. 1 and 2. The system also includes software stored on the memory (70) that, when executed by the processor (58), causes the processor (58) to receive (block 254) an advertisement object (103) and at least one link (105) associated with the advertisement object (103). *Id.*, p. 12, line 17 – p. 13, line 3; FIG. 3A; p. 26, ll. 2-5; and FIG. 7. The at least one link (105) associates the advertisement object (103) with a plurality of image objects (107) corresponding to the advertisement object (103). *Id.*, p. 12, line 17 – p. 13, line 3 and FIG. 3A. Each of the image objects (107) requires a different processing capability to be rendered by the receiver (36). *Id.*, p. 21, line 23 – p. 22, line 16. The software also causes the processor (58) to use the link (105) to select (blocks 258 and 264) one of the plurality of image objects (107) and discard (block 260) the remaining plurality of image objects (107) based on a processing capability of the receiver (36). *Id.*, p. 26, ll. 12-19; FIG. 7; and p. 21, line 23 – p. 22, line 16. The plurality of image objects (107) are transmitted to the receiver (36), and the one of the plurality of image objects (107) is selected (blocks 258 and 264) from the transmitted plurality of image objects (107). *Id.* The selected one of the plurality of image objects (107) is capable of being rendered by the receiver (36). *Id.* The software also causes the processor (58) to display (block 306) the advertisement object (103) and the selected one of the plurality of image objects (107). *Id.*, p. 28, ll. 30 and 31 and FIG. 8.

Independent claim 24 is directed to a method that involves receiving (block 254) an advertisement object (103) and at least one link (105) associated with the

advertisement object (103). *Id.*, p. 12, line 17 – p. 13, line 3; FIG. 3A; p. 26, ll. 2-5; and FIG. 7. The at least one link (105) associates the advertisement object (103) with a plurality of image objects (107) corresponding to the advertisement object (103). *Id.*, p. 12, line 17 – p. 13, line 3 and FIG. 3A. Each of the image objects (107) requires a different processing capability to be rendered by a receiver (36). *Id.*, p. 21, line 23 – p. 22, line 16. The method also involves using the link (105) to select (blocks 258 and 264) one of the plurality of image objects (107) and discard (block 260) the remaining plurality of image objects (107) based on the processing capability of the receiver (36). *Id.*, p. 26, ll. 12-19; FIG. 7; and p. 21, line 23 – p. 22, line 16. The plurality of image objects (107) are transmitted to the receiver (36), and the one of the plurality of image objects (107) is selected (blocks 258 and 264) via the receiver (36) from the transmitted plurality of image objects (107). *Id.* The selected one of the plurality of image objects (107) is capable of being rendered by the receiver (36). *Id.* The method also involves displaying (block 306) the advertisement object (103) and the selected one of the plurality of image objects (107). *Id.*, p. 28, ll. 30 and 31 and FIG. 8.

Independent claim 41 is directed to a system that includes a processor (26) and a computer readable medium coupled to the processor (26). *Id.*, p. 6, ll. 7-11; p. 8, ll. 22-26; and FIG. 1. The system also includes software stored on the computer readable medium that, when executed by the processor (26), causes the processor (26) to generate an advertisement object (103) and generate at least one link (105) associated with the advertisement object (103). *Id.*, p. 11, ll. 15-27;

p. 12, line 17 – p. 13, line 3; and FIG. 3A. The at least one link (105) associates the advertisement object (103) with a plurality of image objects (107) corresponding to the advertisement object (103). *Id.*, p. 12, line 17 – p. 13, line 3 and FIG. 3A. Each of the image objects (107) requires a different processing capability to be rendered by a receiver (36). *Id.*, p. 21, line 23 – p. 22, line 16. The software also causes the processor (26) to transmit the advertisement object (103), the plurality of image objects (107), and the at least one link (105) via a transmission data stream to the receiver (36). *Id.*, p. 11, ll. 15-17. The receiver (36) is to select (blocks 258 and 264) one of the plurality of image objects (107) and discard (block 260) the remaining plurality of image objects (107) based on a processing capability of the receiver (36). *Id.*, p. 26, ll. 12-19; FIG. 7; and p. 21, line 23 – p. 22, line 16. The selected one of the plurality of image objects (107) is capable of being rendered by the receiver (36). *Id.*, p. 21, line 23 – p. 22, line 16.

Independent claim 48 is directed to a receiver (36) that includes an interface (84) configured to communicatively couple the receiver (36) to a television (38) at a subscriber site (20) and a processor (58) to receive an advertisement object (103) and at least one link (105) associated with the advertisement object (103). *Id.*, p. 8, ll. 20-24; FIG. 1; p. 10, line 3; FIG. 2; p. 12, line 17 – p. 13, line 3; and FIG. 3A. The at least one link (105) associates the advertisement object (103) with a plurality of image objects (107) corresponding to the advertisement object (103). *Id.*, p. 12, line 17 – p. 13, line 3 and FIG. 3A. Each of the image objects (107) requires a different processing capability to be

rendered by the receiver (36). *Id.*, p. 21, line 23 – p. 22, line 16. The receiver (36) also includes a communication interface (52) to select (blocks 258 and 264) one of the plurality of image objects (107) using the link (105) and discard (block 260) the remaining plurality of image objects (107) based on a processing capability of the receiver (36). *Id.*, p. 26, ll. 12-19; FIG. 7; and p. 21, line 23 – p. 22, line 16. The selected one of the plurality of image objects (107) is capable of being rendered by the receiver (36). *Id.*, p. 21, line 23 – p. 22, line 16. The receiver (36) also includes a display interface (84) to display (block 306) the advertisement object (103) and the selected one of the plurality of image objects (107). *Id.*, p. 10, line 3; FIG. 2; p. 28, ll. 30 and 31; and FIG. 8

Independent claim 56 is directed to a method that involves generating an advertisement object (103) and generating at least one link (105) associated with the advertisement object (103). *Id.*, p. 11, ll. 15-27; p. 12, line 17 – p. 13, line 3; and FIG. 3A. The at least one link (105) associates the advertisement object (103) with a plurality of image objects (107) corresponding to the advertisement object (103). *Id.*, p. 12, line 17 – p. 13, line 3; FIG. 3A. Each of the image objects (107) requires a different processing capability to be rendered by a receiver (36). *Id.*, p. 21, line 23 – p. 22, line 16. The method also involves transmitting the advertisement object (103), the plurality of image objects (107), and the at least one link (105) via a transmission data stream to the receiver (36). *Id.*, p. 11, ll. 15-17. The receiver (36) is to select (blocks 258 and 264) one of the plurality of image objects (107) and discard (block 260) the remaining plurality of image

objects (107) based on a processing capability of the receiver (36). *Id.*, p. 26, ll. 12-19; FIG. 7; and p. 21, line 23 – p. 22, line 16. The selected one of the plurality of image objects (107) is capable of being rendered by the receiver (36). *Id.*, p. 21, line 23 – p. 22, line 16.

VI. Issues on Appeal

The issues on appeal are whether independent claims 18, 24, 41, 48, and 56 and the claims dependent thereon are allowable over the combination of Gerace and Barrett et al. and the combination of Hite et al. and Barrett et al. suggested in the Office action dated November 27, 2009.

VII. Argument

The Examiner has incorrectly rejected claims 18-34 and 41-67 under 35 § U.S.C. § 103(a) because none of claims 18-34 and 41-67 is rendered *prima facie* obvious by the combination of Gerace and Barrett et al. suggested in the Office action dated November 27, 2009, or the combination of Hite et al. and Barrett et al. suggested in the Office action dated November 27, 2009.

a. Claims 18-34 and 41-67 Are Allowable Over the Suggested Combination of Gerace and Barrett et al.

i. Independent Claim 18

Independent claim 18 is allowable over the combination of Gerace and Barrett et al. suggested by the Examiner. Independent claim 18 is directed to a system to display digital advertisement information that includes, *inter alia*, a receiver for use at a subscriber site, a plurality of image objects corresponding to an advertisement object, each of the image objects requiring a different processing

capability to be rendered by the receiver. In addition, claim 18 recites that a link is used to select one of the plurality of image objects and discard the remaining plurality of image objects based on a processing capability of the receiver. Further, the image objects are transmitted to the receiver and the one of the plurality of image objects is selected from the transmitted plurality of image objects. The combination of Gerace and Barrett et al. suggested in the Office action dated November 27, 2009, does not render claim 18 *prima facie* obvious.

Gerace does not teach or suggest the system of claim 18. For instance, Gerace does not teach or suggest a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site). *Office Action dated November 27, 2009*, p. 14 and *Final Office Action dated March 4, 2009*, pp. 15 and 27. However, the Examiner previously relied on Official Notice to state that it is common practice in the art to transmit or broadcast at least one file in different formats to one or more receivers configured to select for playing or displaying one or more of the transmitted files. *Final Office Action dated March 4, 2009*, pp. 15 and 27.

In response to the Applicants' Pre-appeal Brief traversing the grounds of the Official Notice, the Examiner applied Barrett et al. suggesting that Barrett et al. overcome the deficiencies of Gerace. *Office Action dated November 27, 2009*, p. 14. On the contrary, Barrett et al. do not teach or suggest a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is

selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site). In addition, the Applicants maintain that one of ordinary skill in the art would not have modified Gerace as suggested by the Examiner.

1. Barrett et al. Do Not Overcome The Deficiencies of Gerace

Barrett et al. do not overcome the deficiencies of Gerace. That is, Barrett et al. do not teach or suggest a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site) as recited in claim 18.

The Office action dated November 27, 2009, gives the term 'image objects' two disparate meanings in an attempt to read claim 18 on the prior art. In the context of claim 18, the term 'image objects' is something that can be rendered and displayed by a receiver. *See claim 18* ("... each of the image objects requires a different processing capability to be rendered by the receiver..." and "display the advertisement object and the selected one of the plurality of image objects.") (emphasis added). Under Gerace, the Office action gives the term 'image objects' a completely different meaning than under Barrett et al. Under Gerace, the Office action considers the term 'image objects' to mean a graphic/video component to be displayed or rendered by a receiver. *Office Action dated November 27, 2009*, p. 12, ll. 15-22. However, under Barrett et al., the Office action considers the term 'image objects' to mean a program image from which a read only memory of a

reprogrammable communication device is reprogrammed. *Office Action dated November 27, 2009*, p. 14, ll. 12-18.

While Gerace describes a server that selects appropriate advertisement objects for transmission to and display at a user's computer (*Gerace*, 28:25-29, 11:10-17, and 13:23-25), Barrett et al. describe a reprogrammable network communication device having a reprogrammable read only memory that can be reprogrammed based on new program images (*Barrett et al.*, 1:57-2:10). The new program images described by Barrett et al. are not graphic/video components that are renderable or displayable, but are instead information files or portions thereof for programming the reprogrammable network communication device. *Barrett et al.*, ("... the new program image includes a new network information file block...", "... the configuration information in the current network information file block includes a MAC address, network media configuration information, host interface configuration information, product configuration information, processor configuration information and memory configuration information.").

Therefore, Barrett et al. do not overcome the deficiencies of Gerace, because Barrett et al. do not teach or suggest a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site) as recited in claim 18 and within the meaning of image objects in the context of claim 18. Accordingly, the combination of Gerace and

Barrett et al. suggested in the Office action does not teach or suggest each and every element of claim 18 and, thus, does not render claim 18 *prima facie* obvious.

2. One of Ordinary Skill in the Art Would Not Have Modified Gerace as Suggested by the Examiner

The Applicants maintain that one of ordinary skill in the art would not have modified Gerace as suggested by the Examiner. As noted above, claim 18 recites a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site). Gerace describes the opposite of transmitting a plurality of image objects to a receiver, selecting one of the plurality of image objects and discarding the remaining plurality of image objects. The efficiencies of information transmissions afforded by the techniques described by Gerace are such that one of ordinary skill in the art, at the time of the instant invention, would not have modified Gerace as suggested by the Examiner.

When the prior art teaches away from combining known elements, a claimed invention combining such elements is more likely to be nonobvious. *KSR Int'l. Co. v. Teleflex Inc. et al.*, 550 U.S. 398, 416 (2007) (*citing U.S. v. Adams*, 383 U.S. 39, 51-52 (1996)). In *U.S. v. Adams*, the prior art warned that risks were involved in using the types of electrodes that Adams had used in designing his battery. *Id.* Recognizing this type of teaching away of the prior art, the Supreme Court rejected the Government's claim that the battery designed by Adams was obvious. *Id.* Of significance here is the Court recognizing that a teaching away need not be an absolute proscription against combining elements. In *U.S. v.*

Adams, the teaching away was a warning of risks in combining known elements, but not necessarily a statement that such elements must never be combined. Similarly, here, the prior art warns against wasteful and inefficient use of communication bandwidth resources.

Turning to Barrett et al., Barrett et al. describe using a new program image to program a network board only when compatibility of such a new program image with the network board is confirmed. *Barrett et al.*, 16:60-17:7. Thus, in Barrett et al., some new program images transmitted to a network board may not be used when compatibility is not confirmed. In such instances, communication resources would be unnecessarily and inefficiently expended without using the communicated information (i.e., a communicated new program image).

Subsequent prior art warns against inefficient use of communication resources that could result in poor network and application performance. *See e.g. Tien et al.* (cited by Examiner in the Office action dated November 27, 2009), ¶ [0006] ("To carry out a remote debugging operation, a user has to rely on an object-to-object invocation by sending an object specific proxy to a server. Such processes are often inconvenient, time consuming and more complicate [sic] due to the fact that more client-server interactions are required before a debugging operation can be completed.") (emphasis added). Further, the prior art advocates for reducing the amount of information transmitted over communication paths. *Id.*, ¶ [0016] ("Preferably, such improved system [sic] would also reduce the size and the required interactions between the server and the client for performing the

remote debugging. Thus, the data traffic load over the network system can be reduced and the wait-time for completing an application program involves [sic – involving] the remote scripting operations can be significantly improved and the applications can be more expeditiously performed.") (emphasis added).

In line with improved practices of the prior art to reduce the amount of information needed to be communicated over a communication path, Gerace performs compatibility checks at a server for advertisement objects and transmits to a user computer only information that is certain to be displayed at the user computer. In particular, Gerace describes a server (27) (not a receiver at a subscriber site) that stores a user computer object (37b). *Gerace*, p. 11, ll. 12-33. The user computer object (37b) informs the server (27) of the capabilities of a user's computer. *Id.*, p. 11:10-17 ("... User Computer Object 37b provides an indication of the limitations and capabilities of the user's computer system. For example, User Computer Object 37b lists whether the user's system provides audio and/or video display, and what Web browser software is utilized by the user's system.")

The server (27) selects appropriate advertisement objects for transmission so that a user's computer need not perform such selection. *Gerace*, 28:25-29 ("... main routine 39 selects and includes advertisements on the newly assembled page/screen view at server 27... if the advertisements there are appropriate for the user..."); 27:1 and 2 ("Main routine 39 transmits the screen view for display to the user."). Thus, all of the advertisement objects transmitted by the server (27) to the

user's computer are displayed unconditionally by the user's computer. *Id.*, 13:23-25 ("...the set of Page Display Objects 35a-35c defines the screen views transmitted and displayed to end users.").

Thus, although Gerace teaches receiving at a user's computer, advertisements to be displayed, the user's computer does not select one of a plurality of image objects based on a processing capability of the computer. As noted above, the user computer object (37b) is stored at the server (27) for use by the server (27) in selecting and transmitting the advertisements. In this manner, because the server (27) selects the appropriate advertisements for transmission, the user's computer need not select which advertisements to display. Instead, the user's computer in Gerace processes and displays unconditionally all of the advertisements transmitted by the server (27). In this manner, communication bandwidth is not inefficiently used or wasted by transmitting information that will not be used. Thus, Gerace describes the opposite of transmitting a plurality of image objects to a receiver, selecting one of the plurality of image objects and discarding the remaining plurality of image objects.

The Examiner's proposition to modify Gerace against the teachings of the prior art that warn against transmitting more information than necessary would be contrary to common sense. The Examiner suggests that one of ordinary skill in the art would have modified Gerace to arrive at the claimed invention "thereby saving important resources or reducing bandwidth usage at the server level, while preventing bottleneck, often triggered by heavy traffic, that often renders a network

sluggish..." *Office Action dated November 27, 2009*, p. 15:4-12. On the contrary, the techniques described by Gerace (i.e., selecting at the server (27) only the information that will be displayed at a user's computer and transmitting only such selected information) already save important communication resources such as bandwidth, while preventing bottlenecks and heavy traffic, by transmitting from the server (27) only the information that will be displayed at a user's computer. Gerace reduces the amount of information transmitted and, thus, the amount of bandwidth needed to transmit such information. Modifying Gerace as suggested by the Examiner would create the opposite effect by using up additional communication resources for transmitting additional image objects that are eventually discarded at a user's computer. Modifying Gerace to transmit a plurality of image objects as recited in claim 18 would have been contrary to the practice of preserving limited bandwidth. That is, transmitting a plurality of image objects when some will certainly be discarded would have been regarded as a wasteful use of data communication bandwidth at the time of the invention.

In view of the foregoing, the Applicants submit that one of ordinary skill in the art would not have been motivated to modify Gerace in view of Barrett et al. in the manner suggested by the Examiner. Accordingly, the combination of Gerace and Barrett et al. suggested by the Examiner does not render independent claim 18 *prima facie* obvious. Thus, independent claim 18 and all claims dependent thereon are allowable over the combination of Gerace and Barrett et al. suggested by the Examiner.

ii. Independent Claim 24

Independent claim 24, directed to a method of displaying advertisements, and claims 25-34 dependent thereon are also allowable over the combination of Gerace and Barrett et al. suggested by the Examiner for at least the reasons discussed above in connection with independent claim 18.

iii. Independent Claim 41

Independent claim 41, directed to a system for generating digital advertisements, and claims 42-47 dependent thereon, are also allowable over the combination of Gerace and Barrett et al. suggested by the Examiner for at least the reasons discussed above in connection with independent claim 18.

iv. Independent Claim 48

Independent claim 48, directed to a receiver, and claims 49-55 dependent thereon, are also allowable over the combination of Gerace and Barrett et al. suggested by the Examiner for at least the reasons discussed above in connection with independent claim 18.

v. Independent Claim 56

Independent claim 56, directed to a method of generating digital advertisements, and claims 57-67 dependent thereon are also allowable over the combination of Gerace and Barrett et al. suggested by the Examiner for at least the reasons discussed above in connection with independent claim 18.

b. Claims 18-34 and 41-67 Are Allowable Over the Combination of Hite et al. and Barrett et al.

i. Independent Claim 18

Independent claim 18 is allowable over the combination of Hite et al. and Barrett et al. suggested by the Examiner. Independent claim 18 is directed to a system to display digital advertisement information that includes, *inter alia*, a receiver for use at a subscriber site, a plurality of image objects corresponding to an advertisement object, each of the image objects requiring a different processing capability to be rendered by the receiver. In addition, claim 18 recites that a link is used to select one of the plurality of image objects and discard the remaining plurality of image objects based on a processing capability of the receiver. Further, the image objects are transmitted to the receiver and the one of the plurality of image objects is selected from the transmitted plurality of image objects. The combination of Hite et al. and Barrett et al. suggested in the Office action dated November 27, 2009, does not render claim 18 *prima facie* obvious.

Hite et al. do not teach or suggest the system of claim 18. For instance, Hite et al. do not teach or suggest a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site). *Office Action dated November 27, 2009*, p. 26.

Barrett et al. do not teach or suggest a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a

subscriber site). In addition, one of ordinary skill in the art would not have modified Hite et al. as suggested by the Examiner.

1. Barrett et al. Do Not Overcome The Deficiencies of Hite et al.

Barrett et al. do not overcome the deficiencies of Hite et al. That is, Barrett et al. do not teach or suggest a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site) as recited in claim 18.

In the context of claim 18, the term 'image objects' is something that can be rendered and displayed by a receiver. *See claim 18* ("... each of the image objects requires a different processing capability to be rendered by the receiver..." and "display the advertisement object and the selected one of the plurality of image objects.") (emphasis added). However, under Barrett et al., the Office action considers the term 'image objects' to mean a program image from which a read only memory of a reprogrammable communication device is reprogrammed. *Office Action dated November 27, 2009*, p. 14, ll. 12-18. This is inconsistent with claim 18 and inconsistent with Hite et al. In particular, Hite et al. describe receiving commercials and processing those commercials at an ad administration facility (100) for transmission via an ad transmission facility (200) to end viewers at a display site (400). *Hite et al.*, 9:2-37.

Therefore, Barrett et al. do not overcome the deficiencies of Hite et al., because Barrett et al. do not teach or suggest a plurality of image objects

transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site) as recited in claim 18 and within the meaning of the term 'image objects' in the context of claim 18. Accordingly, the combination of Hite et al. and Barrett et al. suggested in the Office action dated November 27, 2009, does not teach or suggest each and every element of claim 18 and, thus, cannot render claim 18 *prima facie* obvious.

**2. One of Ordinary Skill in the Art Would Not Have Modified
Hite et al. as Suggested by the Examiner**

One of ordinary skill in the art would not have modified Hite et al. as suggested by the Examiner. As noted above, claim 18 recites a plurality of image objects transmitted to a receiver and that one of the plurality of image objects is selected while the remaining are discarded based on a processing capability of the receiver (at a subscriber site). To avoid a receiving unit having to receive a plurality of image objects, select one of the plurality of image objects, and discard the remaining plurality of image objects, Hite et al. describe that commercials are received and processed at an ad administration facility (100) for playback and transmission to end viewers via an ad transmission facility (200). *Hite et al.*, 9:2-28. The processed commercials are received at a receiver (410) at a display site from the transmission facility (200), and the receiver (410) merely demodulates, decodes, and displays the commercials. *Id.*, 13:58-14:58. Thus, the administration facility (200) pre-packages and modulates complete commercials with all of its content (e.g., including images) so that the receiver (410) need only

demodulate the commercials and present them to viewers without needing to select only one image object and discard the remaining image objects.

Hite et al. describe the use of CIDs for selectively presenting commercials to appropriate viewers. *Hite et al.*, 8:18-22. Such CIDs are selected by a marketing organization based on needs and wants of viewers. *Id.* The CIDs are compared at a receiver to CIDs in received commercials to determine what commercials to display. *Id.* 17:15-30. However, Hite et al. do not teach or suggest using such CIDs to represent capabilities of a receiver or to select only one of a plurality of image objects associated with a commercial and discarding the remaining image objects. In contrast, the plurality of image objects of claim 18 are associated with the same advertisement object and one of the image objects is selected in claim 18 based on the processing capabilities of the receiver.

Similar to Gerace discussed above, Hite et al. reduce the amount of information that is transmitted over a communication path to a receiver by packaging in a commercial transmission only information that will be displayed in connection with the transmitted commercial. Also similar to Gerace, Hite et al. reduce the amount of work performed by a receiver by pre-packaging exactly what a receiver will present to a viewer without including additional information for that commercial that a receiver must eventually discard. Although Hite et al. describe discarding whole commercials based on CIDs, such discarding of whole commercials is based on target marketing rather than based on receiver capabilities and such discarding does not constitute selecting one of a plurality of

image objects for a commercial and discarding the remaining plurality of image objects associated with the commercial.

Modifying Hite et al. would contradict common sense and improved practices in the prior art. While Hite et al. provide in each commercial transmission only that information necessary for decoding and presenting the commercial at a receiver, modifying Hite et al. as suggested by the Examiner would result in unnecessarily creating network communication burdens and decreasing distribution network and receiver performance – effects that are contrary to the teachings of the prior art. See e.g. *Tien et al.*, ¶ [0006] (“To carry out a remote debugging operation, a user has to rely on an object-to-object invocation by sending an object specific proxy to a server. Such processes are often inconvenient, time consuming and more complicate [sic] due to the fact that more client-server interactions are required before a debugging operation can be completed.”) (emphasis added). Further, the prior art advocates for reducing the amount of information transmitted over communication paths. *Id.*, ¶ [0016] (“Preferably, such improved system [sic] would also reduce the size and the required interactions between the server and the client for performing the remote debugging. Thus, the data traffic load over the network system can be reduced and the wait-time for completing an application program involves [sic – involving] the remote scripting operations can be significantly improved and the applications can be more expeditiously performed.”) (emphasis added).

In view of the foregoing, the Applicants submit that one of ordinary skill in the art would not have been motivated to modify Hite et al. in view of Barrett et al. Accordingly, the combination of Hite et al. and Barrett et al. suggested by the Examiner does not render independent claim 18 *prima facie* obvious. Thus, independent claim 18 and all claims dependent thereon are allowable over the combination of Hite et al. and Barrett et al. suggested by the Examiner.

ii. Independent Claim 24

Independent claim 24, directed to a method of displaying advertisements, and claims 25-34 dependent thereon are also allowable over the combination of Hite et al. and Barrett et al. suggested by the Examiner for at least the reasons discussed above in connection with independent claim 18.

iii. Independent Claim 41

Independent claim 41, directed to a system for generating digital advertisements, and claims 42-47 dependent thereon, are also allowable over the combination of Hite et al. and Barrett et al. suggested by the Examiner for at least the reasons discussed above in connection with independent claim 18.

iv. Independent Claim 48

Independent claim 48, directed to a receiver, and claims 49-55 dependent thereon, are also allowable over the combination of Hite et al. and Barrett et al. suggested by the Examiner for at least the reasons discussed above in connection with independent claim 18.

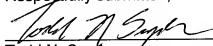
v. Independent Claim 56

Independent claim 56, directed to a method of generating digital advertisements, and claims 57-67 dependent thereon are also allowable over the combination of Hite et al. and Barrett et al. suggested by the Examiner for at least the reasons discussed above in connection with independent claim 18.

VIII. Conclusion

In view of the foregoing, the Applicants respectfully submit that the Examiner has improperly rejected claims 18-34 and 41-67 as allegedly unpatentable over Gerace in view of Barrett et al. and allegedly unpatentable over Hite et al. in view of Barrett et al. Accordingly, the Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103 and respectfully submit that independent claims 18, 24, 41, 48, and 56 and all claims dependent thereon are in condition for allowance.

Respectfully submitted,



Todd N. Snyder
Registration No. 41,320
Attorney for Applicants

Dated: April 30, 2010
The DIRECTV Group, Inc.
RE / R11 / A109
P.O. Box 956
2250 E. Imperial Highway
El Segundo, CA 90245
310-964-0560

APPENDIX A

1-17. (Canceled)

18. (Previously Presented) A system to display digital advertisement information, the system comprising:

a receiver for use at a subscriber site;

a processor in the receiver;

a memory communicatively coupled to the processor in the receiver;

and

software stored on the memory that, when executed by the processor, causes the processor to:

receive an advertisement object and at least one link associated with the advertisement object, wherein the at least one link associates the advertisement object with a plurality of image objects corresponding to the advertisement object, and wherein each of the image objects requires a different processing capability to be rendered by the receiver;

use the link to select one of the plurality of image objects and discard the remaining plurality of image objects based on a processing capability of the receiver, wherein the plurality of image objects are transmitted to the receiver and the one of the plurality of image objects is selected from the transmitted plurality of image objects, and wherein the selected one of the plurality of image objects is capable of being rendered by the receiver; and
display the advertisement object and the selected one of the plurality of image objects.

19. (Previously Presented) The system of claim 18, wherein the software is further adapted to be executed by the processor to select the advertisement object based on a user's preference.

20. (Previously Presented) The system of claim 18, wherein the image objects are linked to at least a second advertisement object.

21. (Previously Presented) The system of claim 18, wherein the memory stores a local condition indicative of the processing capability of the receiver.

22. (Previously Presented) The system of claim 18, wherein the software is further adapted to be executed by the processor to select a second advertisement object based on a location of the receiver.

23. (Previously Presented) The system of claim 18, wherein the software is further adapted to be executed by the processor to display the advertisement object based on an ordered list.

24. (Previously Presented) A method of displaying advertisements, the method comprising:

receiving an advertisement object and at least one link associated with the advertisement object, wherein the at least one link associates the advertisement object with a plurality of image objects corresponding to the advertisement object, and wherein each of the image objects requires a different processing capability to be rendered by a receiver;

using the link to select one of the plurality of image objects and discard the remaining plurality of image objects based on the processing capability of the receiver, wherein the plurality of image objects are transmitted to the receiver and the one of the plurality of image objects is selected via the receiver from the transmitted plurality of image objects, and wherein the selected one of the plurality of image objects is capable of being rendered by the receiver; and

displaying the advertisement object and the selected one of the plurality of image objects.

25. (Previously Presented) The method of claim 24, further comprising determining if the received advertisement object is a new version of a previously cached advertisement object and replacing the previously cached advertisement object with the received advertisement object if the received advertisement object is the new version of the previously cached advertisement object.

26. (Previously Presented) The method of claim 25, wherein determining if the received advertisement object is the new version of the previously cached advertisement object includes comparing data elements associated with an advertisement object version.

27. (Previously Presented) The method of claim 24, further comprising comparing a priority of the received advertisement object to a lowest priority associated with a plurality of cached advertisement objects and discarding the received advertisement object if the priority of the received advertisement object is less than or equal to the lowest priority associated with the plurality of cached advertisement objects.

28. (Previously Presented) The method of claim 27, wherein comparing the priority of the received advertisement object to the lowest priority associated with the plurality of cached advertisement objects includes comparing data elements associated with display priority.

29. (Previously Presented) The method of claim 24, further comprising replacing one from a plurality of cached advertisement objects having a lowest priority with the received advertisement object if the priority of the received advertisement object is greater than the lowest priority of the one from the plurality of the cached advertisement objects.

30. (Previously Presented) The method of claim 24, further comprising discarding expired advertisement objects from a cache memory of the receiver.

31. (Previously Presented) The method of claim 30, wherein discarding the expired advertisement objects from the cache memory includes comparing a data element associated with advertisement object expiration to a local time at the receiver.

32. (Previously Presented) The method of claim 24, further comprising selecting the one of the plurality of image objects based on a local condition stored in the receiver indicative of the processing capability of the receiver.

33. (Previously Presented) The method of claim 24, further comprising determining if the received advertisement object is compatible with a user's preference and discarding the received advertisement object if it is not compatible with the user's preference.

34. (Previously Presented) The method of claim 33, wherein determining if the received advertisement object is compatible with the user's preference includes comparing a data element of the advertisement object associated with a descriptor of the user's preference.

35-40. (Canceled)

41. (Previously Presented) A system for generating digital advertisements, the system comprising:

- a processor;
- a computer readable medium coupled to the processor; and
- software stored on the computer readable medium that, when executed by the processor, causes the processor to:
 - generate an advertisement object;
 - generate at least one link associated with the advertisement object, wherein the at least one link associates the advertisement object with a plurality of image objects corresponding to the advertisement object, and wherein each of the image objects requires a different processing capability to be rendered by a receiver; and
 - transmit the advertisement object, the plurality of image objects, and the at least one link via a transmission data stream to the receiver, wherein the receiver is to select one of the plurality of image objects and discard the remaining plurality of image objects based on a processing capability of the receiver, and wherein the selected one of the plurality of image objects is capable of being rendered by the receiver.

42. (Previously Presented) The system of claim 41, wherein the receiver is configured to store therein a respective local condition indicative of the processing capability of the receiver.

43. (Previously Presented) The system of claim 41, wherein the software is further adapted to transmit along with the advertisement object and the at least one network link a data element indicative of at least one of a user preference, a geographic location, a user interface sophistication level, a location within a display unit, a display priority, or a display time.

44. (Previously Presented) The system of claim 41, wherein each of the image objects includes one of video information, graphical information or textual information.

45. (Previously Presented) The system of claim 41, wherein each of the image objects includes data associated with one of a version of the image information, a priority, a sophistication level or an image format.

46. (Previously Presented) The system of claim 41, wherein the image objects are based on a transport protocol.

47. (Previously Presented) The system of claim 41, wherein a first one of the image objects is a non-animated graphic requiring the receiver to have a processing capability to render the non-animated graphic, and wherein a second one of the image objects is an animated graphic requiring the receiver to have a processing capability to render the animated graphic.

48. (Previously Presented) A receiver comprising:
- an interface configured to communicatively couple the receiver to a television at a subscriber site;
 - a processor to receive an advertisement object and at least one link associated with the advertisement object, wherein the at least one link associates the advertisement object with a plurality of image objects corresponding to the advertisement object, and wherein each of the image objects requires a different processing capability to be rendered by the receiver;
 - a communication interface to select one of the plurality of image objects using the link and discard the remaining plurality of image objects based on a processing capability of the receiver, and wherein the selected one of the plurality of image objects is capable of being rendered by the receiver; and
 - a display interface to display the advertisement object and the selected one of the plurality of image objects.

49. (Previously Presented) The receiver of claim 48, wherein the processor is further configured to select the advertisement object based on at least one of a user's preference or a geographic location of the receiver.

50. (Previously Presented) The receiver of claim 48, further comprising a memory configured to store a local condition indicative of the processing capability of the receiver wherein the processor is further configured to select the advertisement object based on the local condition and discard other advertisement objects based on the local condition.

51. (Previously Presented) The receiver of claim 48, further comprising a tuner to receive television programming from a broadcast transmission station.

52. (Previously Presented) The receiver of claim 48, further comprising a display interface configured to display a program guide and overlay the advertisement object and the retrieved image object onto the program guide.

53. (Previously Presented) The receiver of claim 48, wherein the processor is further configured to receive an update list and manage the advertisement object and other cached advertisement objects previously stored in the receiver based on the update list.

54. (Previously Presented) The receiver of claim 53, wherein the processor is further configured to manage the advertisement object by storing the advertisement object based on the update list.

55. (Previously Presented) The receiver of claim 53, wherein the processor is further configured to manage the cached advertisement objects by discarding at least some of the cached advertisement objects based on the update list.

56. (Previously Presented) A method of generating digital advertisements, comprising:

generating an advertisement object;

generating at least one link associated with the advertisement object, wherein the at least one link associates the advertisement object with a plurality of image objects corresponding to the advertisement object, and wherein each of the image objects requires a different processing capability to be rendered by a receiver; and

transmitting the advertisement object, the plurality of image objects, and the at least one link via a transmission data stream to the receiver, wherein the receiver is to select one of the plurality of image objects and discard the remaining plurality of image objects based on a processing capability of the receiver, and wherein the selected one of the plurality of image objects is capable of being rendered by the receiver.

57. (Previously Presented) The method of claim 56, further comprising replacing a cached advertisement object previously stored in the receiver with the advertisement object if the advertisement object is a new version of the cached advertisement object.

58. (Previously Presented) The method of claim 57, further comprising comparing via the receiver data associated with the advertisement object with data stored in the receiver to determine whether the advertisement object is the new version of the cached advertisement object.

59. (Previously Presented) The method of claim 56, further comprising if the received advertisement object is not compatible with the receiver based on a local condition stored in the receiver indicative of a processing capability of the receiver, discarding the advertisement object via the receiver.

60. (Previously Presented) The method of claim 56, further comprising comparing via the receiver a priority level of the advertisement object to a second priority level and discarding the advertisement object via the receiver if the priority level of the advertisement object is less than or equal to the second priority level.

61. (Previously Presented) The method of claim 56, further comprising comparing via the receiver a priority level of the advertisement object to a second priority level and replacing a cached advertisement object previously stored in the receiver with the advertisement object if the priority level of the advertisement object is greater than the second priority level.

62. (Previously Presented) The method of claim 56, further comprising discarding other advertisement objects via the receiver based on at least one of a user's preference or a geographic location of the receiver.

63. (Previously Presented) The method of claim 56, further comprising displaying a program guide and overlaying the advertisement object and one of the image objects onto the program guide via the receiver.

64. (Previously Presented) The method of claim 56, further comprising receiving at the receiver an update list and using the update list to manage via the receiver the advertisement object received at the receiver and cached advertisement objects previously stored in the receiver.

65. (Previously Presented) The method of claim 64, wherein managing via the receiver the advertisement object received at the receiver includes storing in the receiver the advertisement object based on the update list.

66. (Previously Presented) The method of claim 64, wherein managing via the receiver the cached advertisement objects includes discarding at least some of the cached advertisement objects from the receiver based on the update list.

67. (Previously Presented) The method of claim 56, wherein a first one of the image objects is a non-animated graphic requiring the receiver to have a processing capability to render the non-animated graphic, and wherein a second one of the image objects is an animated graphic requiring the receiver to have a processing capability to render the animated graphic.

IX. Evidence Appendix

See attached APPENDIX B and APPENDIX C.

X. Related Proceedings Appendix

None.

APPENDIX B

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

PD-980142

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

NOV 05 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT G. ARSENAULT and TAM T. LEMINH

Appeal No. 2004-0845
Application No. 09/492,725

ON BRIEF

Before HAIRSTON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 18-47, which are all the claims remaining in the application.

We affirm-in-part.

BACKGROUND

The invention relates to digital video transmission systems and, in particular, to a system and method for transmitting, receiving, and displaying advertisements via a digital video transmission system. Claim 18 is reproduced below.

18. A digital advertisement system for use in receiving, processing and displaying digital advertisement information, the digital advertisement system comprising:

a processor;

a memory communicatively coupled to the processor;

a first software routine stored on the memory and adapted to be executed by the processor to receive advertising objects and image objects linked to the advertising objects from a transmitted data stream;

a second software routine stored on the memory and adapted to be executed by the processor to select a first group of advertising objects from the received advertising objects and image objects based on a local condition; and

a third software routine stored on the memory and adapted to be executed by the processor to sequentially display the first group of advertising objects using ones of the image objects linked to the first group of advertising objects.

The examiner relies on the following reference:

Hite et al. (Hite)

5,774,170

Jun. 30, 1998
(filed Dec. 13, 1994)

Claims 18-47 stand rejected under 35 U.S.C. § 102 as being anticipated by Hite.

We refer to the Final Rejection (Paper No. 4) and the Examiner's Answer (Paper No. 10) for a statement of the examiner's position and to the Brief (Paper No. 9) and

the Reply Brief (Paper No. 13) for appellants' position with respect to the claims which stand rejected.

OPINION

Appellants submit (Brief at 7) that the claims stand or fall together. However, appellants' arguments are not consistent with the proposed grouping. We will consider the limitations of the claims discussed by appellants (i.e., the independent claims), with the dependent claims standing or falling with the corresponding independent claims. See 37 CFR § 1.192(c)(7) (1997); 37 CFR § 41.37(c)(1)(vii) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

Instant claim 41 requires, inter alia, software to generate a plurality of advertisement objects, each of which includes data elements associated with scheduling and display of one of the digital advertisements, generate an identifier object having specified data elements, and link image objects containing image information associated with the digital advertisements to the advertisement objects. The examiner has not pointed out where all the claimed features may be found in Hite, but appears to rely on a finding of inherency; i.e., that the "formats" are "practiced in the television industry and known to those skilled in the art." (Answer at 11.)

If what claim 41 requires is "inherent" in Hite, the examiner could have, and should have, provided an additional reference. When a reference is silent about an

asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Mere allegations of inherency, however, are not sufficient.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

(citations omitted).

We thus cannot sustain the rejection of claim 41 and its dependent claims.

Independent claims 18 and 24 require, as appellants note, the use of linkages between advertising objects and image objects. We do not find any satisfactory response to the argument from the examiner. Nor does the statement of the rejection point out where corresponding disclosure may be found in the reference.

In the remarks bridging pages 17 and 18 of the Answer, the examiner contends that linking one object to another is "inherently practiced" in the field of object-oriented programming. The rejection has not established, however, that Hite discloses, expressly or inherently, the linkage as required by claims 18 and 24.

We thus cannot sustain the rejection of independent claim 18 or 24, nor their dependent claims.

We disagree with appellants, however, that independent claim 35 requires any form of linkage as set forth in the other independent claims. The claim recites generating a first ordered list associated with a first advertisement display portion of the user interface. Hite discloses (col. 4, ll. 45-51) that the Commercial Identifier (CID) code may be sequential such that a viewer would see a series of commercials in correct order, thus disclosing a "first ordered list." The "first advertisement display portion," as broadly claimed, does not distinguish over any or all portions of a video screen on which the commercial advertisements are displayed. Claim 35 further recites sequentially displaying advertisements in this display position based on the ordered list, consistent with Hite's disclosure.

Finally, claim 35 recites that the first ordered list contains a prioritized sequence of "advertising objects." A principal point of contention between the examiner and appellants relates to interpretation of the claim terms "advertising objects" and "image objects." Appellants argue that the "objects" must be interpreted as digital data structures with characterizing data elements. The examiner submits (e.g., Answer at 14) that the terms may be interpreted as requiring no more than graphical video images that can be perceived on a video screen. Unlike the other independent claims on appeal, the patentability of claim 35 reduces to consideration of the broadest reasonable interpretation of "advertising objects."

Appellants argue that the "objects" in the claims are defined by the instant specification and must be interpreted accordingly. Appellants refer us, in the briefs, to

portions of the disclosure where the definitions are thought to be set forth. We are mindful, however, that claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969).

We have studied the instant specification, but find only exemplary embodiments that do not necessarily limit the literal term "advertising objects," devoid of modifiers that relate to the art of object-oriented programming as the term appears in claim 35. Our findings are, in short, consistent with appellants' admonitions set out in the paragraph bridging pages 4 and 5 of the Brief. We do not find any special definitions set forth in the disclosure to narrow the term as used in the claim. Cf. In re Paulsen, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (repeating the principle that where an inventor chooses to be his own lexicographer and gives terms uncommon meanings, he must set out the uncommon definition in the patent disclosure). See also Beachcombers Int'l, Inc. v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994) ("As we have repeatedly said, a patentee can be his own lexicographer provided the patentee's definition, to the extent it differs from the conventional definition, is clearly set forth in the specification."); Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999) (there is a "heavy presumption" that claim language has its ordinary meaning).

Applicants for patent may amend their claims if the language is not limited to the scope intended. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."

Zletz, 893 F.2d at 321, 13 USPQ2d at 1322.

We therefore sustain the rejection of claim 35 and its dependent claims (36-40), but not the rejection that is applied against the remainder of the claims.

CONCLUSION

We affirm the rejection under 35 U.S.C. § 102 over Hite with respect to claims 35-40, but reverse with respect to claims 18-34 and 41-47. The examiner's decision in rejecting claims 18-47 is thus affirmed-in-part.

Appeal No. 2004-0845
Application No. 09/492,725

THE DIRECTV GROUP INC
PATENT DOCKET ADMINISTRATION RE/R11/A109
P O BOX 956
EL SEGUNDO , CA 90245-0956



APPENDIX C

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,725	01/27/2000	Robert G. Arsenault	PD-980142	1296
20991 7590 09/08/2009 THE DIRECTV GROUP, INC. PATENT DOCKET ADMINISTRATION CA / LA1 / A109 2230 E. IMPERIAL HIGHWAY EL SEGUNDO, CA 90245				
EXAMINER JANVIER, JEAN D				
ART UNIT		PAPER NUMBER		
3688				
MAIL DATE		DELIVERY MODE		
09/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<h2 style="text-align: center;">Notice of Panel Decision from Pre-Appeal Brief Review</h2>	Application/Control No. 09/492,725	Applicant(s)/Patent under Reexamination ARSENAULT ET AL.	
	ROBERT WEINHARDT	Art Unit 3688	

This is in response to the Pre-Appeal Brief Request for Review filed

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☐ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☐ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☒ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) ROBERT WEINHARDT

(3) Jean Janvier

(2) _____

(4) V. Millin

/ROBERT WEINHARDT/
Supervisory Patent Examiner, Art
Unit 3688